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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,572	02/17/2004	Krzysztof Antoni Zaklika	197-001-USP	9281
45346 7590 10/23/2008 HENSLEY KIM & HOLZER, LLC 1660 LINCOLN STREET, SUITE 3000 DENVER, CO 80264				
EXAMINER DESIRE, GREGORY M				
ART UNIT		PAPER NUMBER		
2624				
MAIL DATE		DELIVERY MODE		
10/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/781,572

Applicant(s)

ZAKLIKA ET AL.

Examiner

Gregory M. Desire

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-33 and 35-51 is/are rejected.
7) ☒ Claim(s) 34-44 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 8/10/04 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date 9/15/08
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/15/08 has been entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 4-5, 26, 30-31 and 51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4, 7-

9, 13 and 16-20 of copending Application No. 10/955,557. Although the conflicting claims are not identical, they are not patentably distinct from each other because regarding independent claims 1, 26 and 51 of the instant application, copending claims 4 and 16 of the instant application fully discloses the limitations of the independent claims of the instant application. Regarding claims 4-5 and 30-31 of the instant application are similarly rejected by claims 7-9 and 16-19 of the copending application

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying

subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

Regarding claims 1, 26 and 51 Hamburg discloses,

Sampling pixels in a first region within a tool impression in a digital image to determine a first distribution of a pixel property of the pixels in the first region (note col. 6, lines 39-43, predefined color sampled, statistically derived);

Sampling pixels in a second region (column 7, lines 42-43: current: current color at the center of the brush) within the tool impressions to determine a second distribution of the pixel property of the pixels in the second region (column 6, lines 39-43: predefined color sampled, statistically derived; column 6, lines 43-49: predefined statistical profile for background or foreground colors); and

Editing at least one pixel within the tool impression based on the first and second distributions (note col. 6 lines 36-42 and 48-52, color match value are values for each pixel in the digital image indicates the degree of matching based on the sampling of the two regions that is used erasure and decontamination process examiner interprets as editing).

Regarding claims 2 and 27 Hamburg discloses,

Altering an editable pixel property of the at least one pixel (note col. 7 lines 54-56, examiner interprets the possible erasure of pixels as altering procedure and property used for erasing is the editable pixel property of the pixel).

Regarding claims 3 and 28 Hamburg discloses,

Altering an editable pixel property of the at least one pixel, the editable pixel property being different that the sampled pixel property (note col. 8 lines 39-45, alpha value is the property erased, which is different from the color which is sampled pixel property).

Regarding claims 4 and 29 Hamburg discloses,

Wherein the first and second regions represent differently-located subdivisions of the tool impressions (note col. 7 lines 20-24)

Regarding claims 5 and 30 Hamburg discloses,

Editing the at least one pixel within the tool impression according to an edit profile based on the first and second distribution of the pixel property (column 7, lines 13-15; column 8, lines 20-25; figure 3b).

Regarding claims 6 and 31 Hamburg discloses,

Wherein the edit profile is determined by classifying the pixel properties as a function of pixel property differences (note figures 3a and 3b).

Regarding claims 7-8 and 32-33 Hamburg discloses,

Wherein the edit profile is determined by classifying the pixel properties into at least two edit classes, each edit class applying a different degree of editing effect (note fig. 3a 203 and fig. 3b 310).

Regarding claims 9 and 34 Hamburg disclose,

Wherein the edit profile is determined by classifying the pixel properties using blind signal separation

Regarding claims 20 and 45 Hamburg discloses,

Editing at least one pixel within each of the first region and the second region of the tool impression based on the first and second distribution of the pixel property (note col. 6 lines 36-42 and 48-52, color match value are values for each pixel in the digital image indicates the degree of matching based on the sampling of the two regions that is used erasure and decontamination process examiner interprets as editing).

Regarding claims 21 and 46 Hamburg discloses,

Wherein the pixel property is a composite pixel property (note col. 5 lines 54-58).

Regarding claims 22 and 47 Hamburg discloses,

Wherein the pixel property is a multidimensional pixel property (note col. 5 lines 54-58).

Regarding claims 23 and 48 Hamburg discloses,

Determining a property value for each of a plurality of pixels within the first region (note col. 7 lines 25-27).

Regarding claims 24 and 49 Hamburg discloses,

Determining location and dimensions of the tool impression within the digital image (note col. 7 lines 18-30).

Regarding claims 25 and 50 Hamburg discloses,

Identifying the pixel in the first region within the tool impression of the digital image (note col. 7 lines 53-61); and

Identifying the pixels in the second region within the tool impression of the digital image (note col. 7 lines 53-61, identifying pixels in another region, shows multiple regions).

Allowable Subject Matter

5. Claims 34-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. The following is a statement of reasons for the indication of allowable subject matter: The claims further limit the edit profile by classifying or categorizing using specific procedures.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory M. Desire whose telephone number is (571) 272-7449. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

G.D.

October 14, 2008

/Gregory M. Desire/
Primary Examiner, Art Unit 2624